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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,176	01/28/2004	Henry G. Vaughn	1285-001	3820
1009	7590	12/04/2006	EXAMINER	
KING & SCHICKLI, PLLC 247 NORTH BROADWAY LEXINGTON, KY 40507			FERGUSON, MICHAEL P	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/766,176

Applicant(s)

VAUGHN, HENRY G.

Examiner

Michael P. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,15 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,10-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/28/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Species 1, Figures 2,4-7,8 and 11-13, Claims 1-7,10-14 and 16-22, during the phone conversation with Michael T. Sanderson on November 27, 2006 is acknowledged.
2. Claims 8,9,15 and 23-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse.

### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: DECORATIVE RAILING ASSEMBLY FOR A BUILDING.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 10-14, 16-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al. (US 5,078,367).

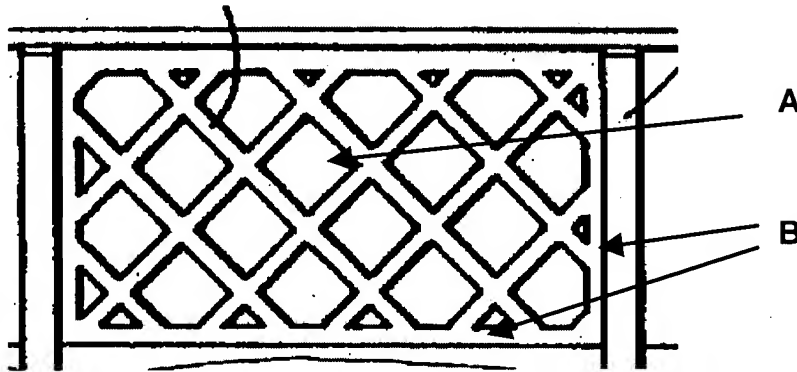
As to claim 1, Simpson et al. disclose a railing assembly for a building, comprising:

two end rails **2** each having a longitudinal extent with comparable dimensions;

and

a decorative panel (lattice **A**; Figure 1 reprinted below with annotations)

connected between the two end rails having a frame **B,3** juxtaposed the end rails and bordering a design pattern (Figure 1).



As to claim 2, Simpson et al. disclose a railing assembly wherein the decorative panel **A** comprises a single workpiece of material (Figure 1).

As to claim 3, Simpson et al. disclose a railing assembly wherein the frame **B,3** is a partial frame (Figure 1).

As to claim 4, Simpson et al. disclose a railing assembly wherein the frame **B,3** borders the design pattern on a top, a bottom, a left and a right side thereof (Figure 1).

As to claim 5, Simpson et al. disclose a railing assembly wherein the frame **B,3** juxtaposes the two end rails **2** for nearly an entirety of the longitudinal extent, the frame having a length dimension shorter than the longitudinal extent of either of the two end rails (Figure 1).

As to claim 6, Simpson et al. disclose a railing assembly wherein the longitudinal extent is not-to-exceed about 8 feet long.

As to claim 7, Simpson et al. disclose a railing assembly including a plurality of posts **4** attached to terminal ends of each of the two end rails **2**, the posts not attached to the frame **B,3** (Figure 1).

As to claim 10, Simpson et al. disclose a railing assembly wherein the frame **B,3** connects substantially perpendicularly to the two end rails **2** (Figure 1).

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As to claim 11, Simpson et al. disclose a railing assembly for a building, comprising:

two end rails **2** each having a longitudinal extent; and

a decorative panel **A** connected between the two end rails having a design pattern and a partial frame **B,3** with at least two edges each juxtaposed and substantially parallel to an entity of the longitudinal extent of one of the end rails, the at least two edges each having a length dimension shorter than the longitudinal extent of either of the two end rails (Figure 1).

As to claim 12, Simpson et al. disclose a railing assembly wherein the decorative panel **A** comprises a single workpiece of material (Figure 1).

As to claim 13, Simpson et al. disclose a railing assembly including a plurality of posts **4** attached to terminal ends of each of the two end rails **2**, the posts not attached to the partial frame **B,3** (Figure 1).

As to claim 14, Simpson et al. disclose a railing assembly wherein the longitudinal extent is not-to-exceed about 8 feet.

As to claim 16, Simpson et al. disclose a railing assembly wherein the partial frame **B,3** connects substantially perpendicularly to the end rails **2** (Figure 1).

As to claim 17, Simpson et al. disclose a building, comprising:

a plurality of upstanding posts **4**; and

a plurality of decorative panels **A**, wherein a single decorative panel exclusively exists between two of the plurality of upstanding posts and each of the plurality of

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decorative panels is formed of a unitary workpiece formed to define a frame **B,3** and a design pattern (Figure 1).

Applicant is reminded that **process limitations are given little patentable weight in product claims** since the patentability determination of product-by-process claims is based on the product itself, even though such claims are limited and defined by the process. See MPEP § 2113. "The patentability of a product does not depend on its method of production. " In re Thorpe, 777 F.2d 695,698,USPQ 964,966 (Fed.Cir.1985).

As to claim 18, Simpson et al. disclose a building including a plurality of end rails **2**, each of the plurality of decorative panels **A** are attached to two of the plurality of end rails, the plurality of upstanding posts **4** attaching to terminal ends of the plurality of end rails, the plurality of upstanding posts not attaching to the frame **B,3** (Figure 1).

As to claim 19, Simpson et al. disclose a building wherein the plurality of upstanding posts **4** are each substantially parallel and are separated by about 8 feet, the terminal ends attaching substantially perpendicularly to the plurality of upstanding posts (Figure 1).

As to claim 20, Simpson et al. disclose a railing assembly for a building, comprising:

two end rails **2** each having a longitudinal extent of not-to-exceed about 8 feet;  
a decorative panel **A** formed of a single workpiece of material connected between the two end rails and having a frame **B,3** juxtaposed the end rails and bordering a substantially coplanar design pattern, the frame having a length dimension

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shorter than the longitudinal extent of either of the two end rails, the design pattern having a substantially symmetrical pattern about a centerline of the decorative panel wherein the centerline extends substantially perpendicular to the longitudinal extent (Figure 1).

As to claim 22, Simpson et al. disclose a railing assembly including a plurality of upstanding posts 4 attached to terminal ends of each of the two end rails 2, the upstanding posts not attached to the frame B,3 (Figure 1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Bebendorf (US 6,772,998).

As to claim 21, Simpson et al. disclose a railing assembly wherein the single workpiece is a plastic, instead of fiberboard.

Bebendorf teach a railing assembly wherein a workpiece is either plastic or fiberboard (column 2 lines 46-51). The applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a railing assembly as disclosed by Simpson et



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al. wherein the workpiece is fiberboard as taught by Bebendorf as such material is a well-known, widely used and commercially available material within the art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to railing assemblies:

Romano (US 3,454,262), Wood (US 3,411,753) and Farmer (US 2,766,015) are cited for pertaining to railing assemblies comprising a decorative panel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (8:00-5:00).

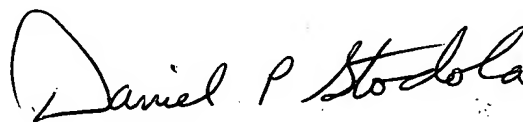
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
MPF

11/27/06



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